

ESTTA Tracking number: **ESTTA131246**

Filing date: **03/21/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Apple Inc.
Granted to Date of previous extension	03/21/2007
Address	1 Infinite Loop Cupertino, CA 95014-2084 UNITED STATES
Party who filed Extension of time to oppose	Apple Computer, Inc. Apple Computer, Inc.
Relationship to party who filed Extension of time to oppose	On January 9, 2007, Apple Computer, Inc. changed its name to Apple Inc. On January 25, 2007 (at Reel/Frame 3468/0463), January 26, 2007 (at Reel/Frame 3469/0280) and on February 8, 2007 (at Reel/Frame 3478/0396), Apple Inc. electronically filed and recorded with the Assignment Division name change requests in connection with its registrations and applications.

Attorney information	John C. Baum, Esq. Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111-3834 UNITED STATES jcb@townsend.com, els@townsend.com Phone:415-576-0200
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Applicant Information

Application No	78644879	Publication date	11/21/2006
Opposition Filing Date	03/21/2007	Opposition Period Ends	03/21/2007
Applicant	imagination Holdings Pty Ltd 64 North Terrace kent Town, South Australia, 5067 AUSTRALIA		

Goods/Services Affected by Opposition

Class 009. All goods and sevicees in the class are opposed, namely: Computer programs and instructional manuals distributed as a unit for use in information storage and retrieval

Attachments	Opposition-DVD I PRO.pdf (5 pages)(180749 bytes)
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Signature	/John C. Baum, Esq./
Name	John C. Baum, Esq.

Date	03/21/2007
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application Serial No.78/644,879
Published: November 21, 2006
Applicant: Imagination Holdings Pty Ltd.
Mark: **DVD i PRO**

APPLE INC.,

Opposer

vs.

IMAGINATION HOLDINGS PTY LTD.

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
P. O. Box 1451
Alexandria, Virginia 22313-1451

Madam:

APPLE INC. ("Opposer"), a California corporation, located and doing business at 1 Infinite Loop, Cupertino, California, 95014, believes that it will be damaged by the registration in International Class 9 of the mark **DVD i PRO** as shown in Application Serial No. 78/644,879 filed by Imagination Holdings Pty Ltd. ("Applicant"), an Australian corporation, with a mailing address at 64 North Terrace, Kent Town, South Australia 5067, Australia, and published in the Official Gazette on November 21, 2006, and hereby opposes registration thereof.

As grounds for opposition, Opposer alleges:

1. Opposer is the owner of Registration No. 2,863,921 for **IDVD** for “software for use on personal computers for the creation, editing, authoring and/or playback of digital versatile disks” in International Class 9. Opposer’s application for said registration was filed on December 16, 1999, and matured to registration on July 20, 2004. Opposer has used the mark **IDVD** on and in connection with the sale of the aforementioned goods since at least as early as January 9, 2001.

2. Opposer also is the owner of Registration No. 2,623,641 for **DVD STUDIO PRO** for “computer software for authoring, distributing, receiving, playing, storing, organizing, editing, encoding and decoding audio, video and multimedia content, and user manuals sold therewith” in International Class 9. Opposer’s application for said registration was filed on January 9, 2001, with a September 29, 2000 44(d) priority claim, and matured to registration on September 24, 2002. Opposer has used the mark **DVD STUDIO PRO** on and in connection with the sale of the aforementioned goods since at least as early as January 9, 2001.

3. Since it first introduced the **IDVD** and **DVD STUDIO PRO** goods at least as early as January 2001, Opposer has used its **IDVD** and **DVD STUDIO PRO** marks in interstate commerce for the above-identified **IDVD** and **DVD STUDIO PRO** goods, and has engaged in extensive and substantial advertising, sales and marketing of those goods under those marks. As a result of these substantial efforts and investment, Opposer’s **IDVD** and **DVD STUDIO PRO** marks are well known to purchasers and the general public who recognize the marks as indicating the source of the goods as Opposer.

4. By virtue of Opposer's extensive use and promotion of the **IDVD** and **DVD STUDIO PRO** marks and goods, Opposer has established valuable goodwill in the **IDVD** and **DVD STUDIO PRO** marks, and the public has come to associate **IDVD** and **DVD STUDIO PRO** with Opposer. As such, the public has come to know **IDVD** and **DVD STUDIO PRO** as indicators of products and services that originate from Opposer.

5. Opposer stylizes its **IDVD** mark with an initial lower-case "i", i.e., iDVD, in promoting its goods to the public and is well-known for the similar stylization of a "family" of registered product marks, including iTunes, iPod, and iMac.

6. Applicant filed U.S. Intent-to-Use Trademark Application Serial No. 78/644,879 (the "Application"), which is the subject of this Opposition, on June 7, 2005, for the mark **DVD I PRO** for "Computer programs and instructional manuals distributed as a unit for use in information storage and retrieval" in International Class 9.

7. Applicant's goods as described in the Application are extremely broad, being software for "information storage and retrieval," and thus encompass and are highly related to Opposer's **IDVD** and **DVD STUDIO PRO** goods, with which Opposer uses its **IDVD** and **DVD STUDIO PRO** marks.

8. Opposer began use of its **IDVD** and **DVD STUDIO PRO** marks in connection with Opposer's **IDVD** and **DVD STUDIO PRO** goods at least as early as January 2001 and its registrations have effective filing dates of December 16, 1999 and September 29, 2000, respectively, all well prior to Applicant's filing date of June 7, 2005.

9. Applicant's **DVD i PRO** mark is similar in sight, sound, and meaning to Opposer's Marks. Applicant has applied to register **DVD i PRO** in a stylization using a lower-

case “i” as used by Opposer for **IDVD** and for many of Opposer’s famous marks. That stylization is closely associated with Opposer in the marketplace. As a result of the similarity between Opposer’s marks and Applicant’s mark, and the highly related nature of the goods offered by Opposer and claimed by Applicant under their respective marks, Applicant’s mark is likely to cause confusion, mistake, or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties’ respective goods.

10. Registration of Applicant’s mark shown in the opposed application will result in damage to Opposer, its good will, and the strength and value of its **IDVD** and **DVD STUDIO PRO** marks under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), pursuant to the allegations stated above.

11. If the Application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the **DVD i PRO** mark. Such registration would cause confusion among consumers as to the separate and distinct sources of Applicant’s goods and Opposer’s goods and the relationship of Opposer to Applicant, thereby damaging Opposer’s goodwill in Opposer’s marks, diluting the value thereof, and resulting in irreparable harm to Opposer’s business and reputation, all to the detriment of Opposer who has expended considerable sums and effort in promoting Opposer’s Marks.

WHEREFORE, Opposer prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 78/644,879 be denied.

Please charge any necessary fee regarding this Opposition to the Deposit Account of Townsend and Townsend and Crew LLP, 20-1430, and credit any overpayment to such deposit account.

Please direct all notices, pleadings and process regarding this matter to:

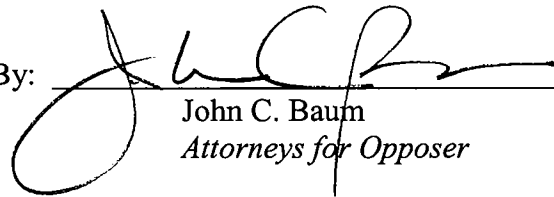
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Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

Dated: March 21, 2007

By: _____

A handwritten signature in black ink, appearing to read 'JCB', is written over a horizontal line.

John C. Baum
Attorneys for Opposer